

Doc Code: AP.PRE.REQ

PTO/SB/33 (08-08)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)									
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		10/816,028	1 April 2004								
		First Named Inventor									
		Bocker, Marcus									
		Art Unit	Examiner								
		1796	Metzmaier, Daniel								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td><u>Howard C. Lee</u> Signature</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td><td><u>Howard C. Lee</u> Typed or printed name</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. 48104 Registration number _____</td><td><u>202 - 292 - 1539</u> Telephone number</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td><u>21 August 2008</u> Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>				<input type="checkbox"/> applicant/inventor.	<u>Howard C. Lee</u> Signature	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<u>Howard C. Lee</u> Typed or printed name	<input checked="" type="checkbox"/> attorney or agent of record. 48104 Registration number _____	<u>202 - 292 - 1539</u> Telephone number	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>21 August 2008</u> Date
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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ARGUMENTS SUPPORTING PRE-APPEAL BRIEF REQUEST FOR REVIEW

The applicants request reconsideration for the rejections of record as a clear error was made in each of the rejections which are addressed individually below.

35 U.S.C 112, second paragraph rejection

1. Claims 1, 2 and 4-20 were rejected because of the limitation "...the at least one active defoaming substance (A) is not the same as the oil-in-water emulsion (B)." The clear error arises in that the Office Action provides no support for the position that one of ordinary skill in the art would find this limitation to be unclear especially when the terms have known meaning within the art.

One of ordinary skill in the art would clearly recognize a defoaming substance (A) acts to reduce or prevent foaming and that an oil-in-water emulsion (B) constitutes an aqueous continuous phase and an oil disperse phase which has at least one organopolysiloxame compound. As claim 1 requires that (A) and (B) are not the same, it is unclear why one of ordinary skill in the art would be unable to determine whether (A) is or is not the same as (B) given the known meanings of the claim terms.

2. Claims 1, 2 and 4-20 were also rejected as it was alleged that the metes and bounds of the limitation "at least one active defoaming substance" is unclear. However, this rejection is a clear error because, as noted above, one of ordinary skill in the art would know that a defoaming substance acts to reduce or prevent foaming and there is no evidence which supports the position that one of ordinary skill in the art could not determine whether a substance reduces or prevents foaming. Moreover, a "metes and bounds" rejection is also a clear error because it has long been held that "[b]readth of a claim is not to be equated with indefiniteness" *See In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)). *See also MPEP 2173.04*.

3. Lastly, both rejections represent a clear error because no suggestions were offered during prosecution for alternative claim language. *See MPEP 707.07(g)* which states in part "[c]ertain technical rejections (e.g. negative limitations, indefiniteness) ***should not be made*** where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition." and *MPEP 2173.02* which states in part "[t]he examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is

satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. ***Examiners are encouraged to suggest claim language*** to applicants to improve clarity or precision of the language used, but ***should not reject claims*** or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.” (emphasis added)

35 U.S.C. 102(b) rejection

Claims 1, 2, 4, 5, 7-15 and 17-19 were rejected as being anticipated over Hosogawa et al. (EP 761 724 – “Hosogawa”). However, this is a clear error because: (1) inherency has not been established and therefore all limitations have not been taught; and (2) *In re Papesch* are inapplicable to the present application.

(1) Inherency has not been established/All claim limitations have not been taught

The burden for establishing inherency is stated in MPEP 2112, sec. IV - To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted).

While polyorganopolysiloxanes were known to have defoaming properties, ***this is not true of polyorganosiloxanes as part of an oil-in-water emulsion for defoaming a cooling lubricant concentrate***. The applicants provided ample evidence of this fact in the table on page 10 of the specification (see listings for Emulsion 1, Emulsion 2 and Emulsion 3).

Therefore, the evidence of record does not support the assertion that polyorganosiloxanes as part of an oil-in-water emulsion would be expected to have defoaming properties when used for defoaming a cooling lubricant concentrate, in fact the opposite is expected. While this is relevant for the method of use claims (claims 11 and 12), it would not be relevant for the

emulsion claims if the other elements of the applicants claimed invention were necessarily present in the teachings of Hosogawa. However, they are not.

(a) *Emulsion Claims*

Other elements of the applicants' emulsion which must be present in the claims are that: (i) the emulsion is aqueous; and (ii) at least one active defoaming substance (A) is present. However, it is not clear that these missing elements are necessarily present in Hosogawa simultaneously with the polyorganosiloxanes as part of an oil-in-water emulsion.

Example 2 is cited as evidence that Hosogawa teaches these missing elements. However, this is incorrect. The initial emulsion formed in Example 2 from the combination of polyoxyethylene lauryl ether, trimethylsiloxy-endblocked dimethylpolysiloxane gum and isoparaffin is a *paste-like* emulsion (see col. 11, line 19 of Hosogawa), i.e. the emulsion is not aqueous at this point in Hosogawa.

It is further noted that while Hosogawa refers to the inclusion of other additives (see e.g. col. 9, lines 14-16), none of these additives are requisite elements of Hosogawa's invention and none of them speak directly to the missing element of a defoaming substance; in fact the only mention of isoparaffin in Hosogawa is in Examples 2 and 4.

Moreover, Hosogawa believed that the organopolysiloxane emulsions of their invention *alone* would have been useful as a defoamer (see col. 10, lines 1-5) and as such would have had no need to add an additional defoamer.

These points are raised because transformation of the paste-like emulsion into an aqueous emulsion requires a dilution with two mixing phases (see col. 11, lines 19-44). The final aqueous dimethylpolysiloxane emulsion which results after these mixing phases make no mention of the presence of isoparaffin and the lack of teaching within Hosogawa about the presence of defoaming substances does not make clear the missing element of a defoamer is necessarily present in the Hosogawa's emulsions.

Therefore, Hosogawa does not anticipate the applicants' emulsion claims (claims 1, 2, 4, 5, 7-10, 13 and 17-19).

(The applicants further note that claims 14 and 15 are directed toward a polymer dispersion and printing ink, respectively, which contain additional elements besides the emulsion of claim 1 which is also not taught by Hosogawa)

(b) Method of Use Claims

Claims 11 and 12 are directed toward the use of the claimed aqueous defoamer emulsions for ***defoaming a cooling lubricant concentrate***. As noted above, there was no indication that of polyorganosiloxanes as part of an oil-in-water emulsion would have defoaming activity.

In addition, there was no indication in the art that use of a defoamer would be effective for defoaming a cooling lubricant concentrate. The applicants' used known defoamers in the art alone in a cooling lubricant concentrate and these defoamers generally showed poor defoaming activity (see table on page 10 of the specification); even for the combination of Defoamer 2 and CL concentrate B some degree of foaming occurred when the CL concentrate was stored for 4 weeks.

The mere mentioning of isoparaffin (which is acknowledged in the final rejections as not directly teaching a use as a defoamer, but merely that it "reads" on at least one defoaming substance claimed) would not lead one of ordinary skill in the art to recognize that any defoamer could be used to defoam a cooling lubricant concentrate, i.e. does not disclose the applicants' method of use claims – claims 11, 12 and 20).

As such, given the disclosed ineffectiveness of both polyorganosiloxanes as part of an oil-in-water emulsion AND defoamers to have defoaming activity for a cooling lubricant concentrate, one of ordinary skill in the art would not have combined these elements and used them for defoaming a cooling lubricant concentrate.

Therefore, Hosogawa does not anticipate the applicants' method of use claims.

(2) In re Papesch are inapplicable to the present application

MPEP 2144.04 states that "...if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." However, the citation to *Papesch* in the final rejection has distorted the citation and meaning from the decision and appears to be mixing the holding of *In re Spada* ("Products of ***identical chemical composition*** can not have mutually exclusive properties." *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)(emphasis added)).

The actual text of *Papesch* reads "From the standpoint of patent law, ***a compound*** and all of its properties are inseparable; they are one and the same thing." *In re Papesch*, 315 F.2d. 381, 391, 137 USPQ 43, 51 (CCPA 1963)(emphasis added).

Regardless of whether *Papesch*, *Spada* or both were intended to be cited, neither holding is appropriate for this application. The applicants are not claiming a compound but a composition which contains more than one compound. In addition, the composition of the present invention has not been shown to have the identical chemical composition with the composition of Hosogawa.

35 U.S.C. 102(b) rejection

Claims 1, 2 and 4-20 were rejected as being anticipated over Schulz et al. (EP 761 724 – “Schulz”). However, this is a clear error because all limitations have not been taught.

The siloxanes disclosed in Schulz are not encompassed by the organopolysiloxanes claimed by the applicants and lack any teaching that their siloxanes have a viscosity of $\geq 1 \times 10^6$ mPas (the viscosity referred to in Schulz refers to the emulsion NOT the siloxane).

35 U.S.C. 103(a) rejections

Claims 11, 12 and 20 were rejected as being obvious of Hosogawa and claims 1, 2 and 4-20 were rejected as being obvious over Schulz alone or in view of Ebbrecht (U.S. Pub. 2004-0137804). These rejections are also in error at least for the fact that all claim limitations are not taught or suggested by the respective references for the reasons cited in the 102(b) rejections. Applicants reserve the right to submit further arguments should an Appeal Brief become necessary.